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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,825	11/30/2001	Michael B. Sundel	002250-2	2660
25570 7590 12/26/2007 ROBERTS, MLOTKOWSKI & HOBBS P. O. BOX 10064 MCLEAN, VA 22102-8064			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT 3691	PAPER NUMBER
			NOTIFICATION DATE 12/26/2007	DELIVERY MODE ELECTRONIC

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LGallagher@rmhlaw.com



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/996,825
Filing Date: November 30, 2001
Appellant(s): SUNDEL, MICHAEL B.

MAILED

DEC 26 2007

GROUP 3600

Jessica M. Egner (Reg. No. 51,646)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on August 24, 2007 appealing from the Office action mailed November 2, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1 and 33 have been amended subsequent to the final rejection.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on July 3, 2007 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0032612	WILLIAMS et al.	3-2002
2003/0069831	LE et al.	4-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

9(a) Claims 1, 2, 4-11, 23-31, 33, 34 and 36-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1, 2, 4-11, 23-31, 33, 34 and 36-51 are rejected under 35 U.S.C. § 112, first paragraph, because these claims include the limitation “electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs”. However, the specification does not provide a written description disclosure to support the claimed limitation of “electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs”.

For the art rejections given below, the claims are interpreted in light of 35 U.S.C. § 112, first paragraph rejections discussed above.

9(b) Claim 1, 2, 4-11, 23-31, 33, 34 and 36-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 33 recite the limitation “tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient

to the Sender". There is no antecedent basis for this limitation because the shipment or return of the package has not been positively recited before this limitation. Appropriate clarification/correction is required. Claims 2, 4-11, 23-31, 34 and 36-51 are rejected by way of dependency on a rejected independent claim.

Claims 1 and 33 also recite the limitation "of the one more items of the items of the package". It is not clear what the applicant means by the term "of the one more items". These claims also recite the limitation "permitting an authorized user to query the database" and "rendering data for display to an authorized user". It is not clear if these two authorized users are the same user or different users. Appropriate clarification/correction is required. Claims 2, 4-11, 23-31, 34 and 36-51 are rejected by way of dependency on a rejected independent claim.

9(c) Claims 33, 34 and 36-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 33, 34 and 36-51 of the disclosed invention are inoperative and therefore lack utility.

Claims 33, 34 and 36-51 merely recite elements of an apparatus or a system ("means for" corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. Figure 6 of the applicant's drawings only shows some hardware elements of the system. It is not clear how these elements are related to the claimed invention. Applicant has not shown how these hardware elements map on to the limitations of the claimed invention.

Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

9(d) Claims 1, 2, 4-11, 23-31, 33, 34 and 36-51 are rejected under 35 U.S.C. 103(a) as being unpatentable Williams et al (US Pub. No. 2002/0032612 A1) in view of Le et al (US Pub. No. 2003/0069831 A1).

Claims 1 and 33, Williams teaches a computer-implemented method and system for processing shipment and return of a package containing items from a Sender to a Recipient (See Williams Abstract), the method comprising the steps of: electronically storing package data, for the package, and including item data, for the items in the package, in a database (See Williams Paragraphs 148-150, 375, Figures 27A and 40); electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender, from a shipping mechanism (See Williams Paragraphs 148-152, 375); electronically adding the shipment tracking data to the database (See Williams Paragraphs 148-152); electronically correlating the package data in the database with the shipment tracking data (See Williams Paragraphs 149, 455-472); and permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package (See Williams Paragraphs 28, 30, 133, 136, 152 and 375-

410) and rendering data for display to an authorized user, based on a query of the database for shipping parameters of the package from the Sender to the Recipient and return from the Recipient to the Sender of the one more items of the items of the package (See Williams Paragraphs 28, 30, 133, 136, 152 and 375-410).

Williams does not explicitly teach the step of electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker.

Le teaches the step of electronically determining whether the package requires customs clearance (See Le Paragraphs 15-18 and 38-41) and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker (See Le Paragraphs 51-54) and also the step of rendering data for display to an authorized user, based on a query of the database for shipping parameters of the package (See Le Paragraphs 52-54).

Both Williams and Le are concerned with providing transport logistics support for users in trading goods. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Riggs to the invention of Williams. The combination of the disclosures taken as a whole, suggests that users would have benefited from the convenience of complying with customs regulations in one session using a user-friendly interface.

Claims 2 and 34, Williams teaches the step of electronically assigning the package to a specific combination of a shipper and shipping method based on the package data (See Williams Figures 12 and 38, Paragraphs 330-371).

Claims 4-11 and 36-43, Williams teaches the steps wherein the package data includes at least the originating address and the destination address (See Williams Figure 27A), and the item data includes a description of the items in the package (See Williams Paragraph 150), said method further comprising the step of: using the package data to electronically calculate shipping charges and electronically generate invoices associated with the shipment (See Williams Paragraph 333); wherein the item data includes the description and value of each item (See Williams Paragraph 150); wherein the step of storing package data comprises transmitting package data via the Internet (See Williams Paragraphs 138, 139 and 142); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network including the Internet in response to the query parameters (See Williams Paragraphs 138, 139 and 142); further comprising the steps of: electronically adding returned item information to the database if items from the package are returned to the Sender (See Williams Paragraph 150); in the case of international shipments, electronically preparing duty and tax refund claims based on the returned item information and the corresponding item data; and electronically adding duty and tax refund information to the database (See Williams Paragraphs 187, 199, 204, 253 and 254, additional components of refund are interpreted to include duty also); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network in response to the query parameters (See Williams Paragraphs 152 and 153); wherein the computer network comprises the Internet (See Williams Paragraphs 142, 152 and 153).

Claims 23-26, 28-30, 44-47 and 49-52, Williams teaches the steps and means of selecting a shipping assignment for the package based on the package data (See Williams Paragraphs 330-

371); generating appropriate shipping documents for the package (See Williams Abstract and Paragraph 17) comprising package labels (See Williams Paragraph 258) and shipping manifests (See Williams Paragraphs 396 and 404); providing a Web site page for permitting the authorized user to query the database (See Williams Paragraphs 173, 174, 179-182); generating duty and tax refund claims based upon Receipt of returned item data (See Williams Paragraphs 497 and 533); adding return item information to said database if items from a package are returned to the Sender (See Williams Paragraph 639), and preparing duty and tax refund claims based on the returned item information (See Williams Paragraphs 497 and 533).

Claims 27 and 48 Le teaches the step wherein shipping documents comprises customs forms (See Le Paragraphs 50-52)

Claims 31, 32 and 52, Williams teaches computer program product including one or more computer-readable instructions configured to cause one or more computer processors to perform the steps recited in claim 1 and a computer system including one or more hardware and/or software devices configured to perform the steps recited in method of claim 1 (See discussion of claims 1 and 33 above). A computer program product and a computer system including one or more hardware and/or software devices are inherent in the disclosure of Williams.

(10) Response to Argument

In response to Appellant's assertion "Appellant submits that the language "electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs, as is recited in independent claims 1 and 33, is fully supported in the original specification as filed. Appellant notes that the first step of the method of the present invention is described in paragraph [0020] and shown in Figure 1 of the Specification. As

described in paragraph [0020], "the first step in the process is the pre-processing of package data. Package data is initially received, in step 112, from the Sender, and rendered as record 616 into a format that can be entered into database 602 (Fig, 6). There can be one record 616 per package or plural records 616 per package, or package data for plural packages can be stored in a single record." As described in paragraph [0020] of the Specification, the first or initial step of the method of claim 1 is receiving and processing package data. Thus, the language "'electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs", as is recited in independent claims 1 and 33, is fully supported in the original specification as filed.", the examiner respectfully disagrees. While the specification discloses pre-processing of package data, there is nothing in the disclosure to indicate whether the package data is received before or after a package is shipped. For instance the sender may ship the package and then send package records electronically. Hence absent explicit disclosure in the Applicant's specification indicating that the storing occurs before shipment occurs, the rejection made under 35 USC 112, first paragraph is maintained by the examiner.

In response to Appellant's arguments "Appellant submits that the limitation has antecedent basis in the preamble of claims 1 and 33. The preamble of claim 1 describes a "method for processing shipment and return of a package containing items from a Sender to a Recipient". Claim 1 then describes, in an element of the claim, "electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender". Because the limitation "tracking shipment of the package from the Sender to the Recipient and

return of one or more items of the items of the package from the Recipient to the Sender" is described first in the preamble, the limitation has antecedent basis. Appellant requests this rejection be withdrawn", the examiner respectfully disagrees. There is no antecedent basis for this limitation because the shipment or return of the package has not been positively recited before this limitation. In fact it is not clear at what step of the method the shipment or return of the package occurs and hence it is not clear as to when the shipment tracking data is generated. In light of this interpretation, the limitation lacks antecedent basis.

In response to Appellant's arguments "Appellant submits that all of the claims are in compliance with 35 U.S.C. § 101 and notes the support for the means-plus-function claim is shown in, for example, FIG. 6 and the discussion in Appellant's published specification thereof; which clearly recites exemplary hardware components corresponding the means plus function claim elements, as recited in claims 33, 34, and 36-51", the examiner respectfully disagrees. As discussed in the rejection under 35 USC 101, the examiner has broadly interpreted the claim as being drawn to elements of an apparatus or a system ("means for" corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. The examiner has not applied the provisions of 35 USC 112, sixth paragraph in interpreting this claim because there is too much structure in the means plus function. Hence this rejection is maintained by the examiner.

In response to Appellant's assertion "First, the prior art itself must suggest the desirability and, therefore, obviousness of a modification of a reference or the combination of references to achieve a claimed invention", the examiner would like to respectfully point out that that KSR

(*KSR International Co. v Teleflex Inc.*, 550 U.S.- 82 USPQ2d 1385 (2007)) forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness.

In response to Appellant's assertion "In response to the rejection of claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 under 35 U.S.C. § 103, as being unpatentable over Williams in view of Le, Appellant refers to the Declaration filed under 37 C.F.R. § 1.132 on November 30, 2001. The Declaration indicates the commercial success of the present invention. The Declaration was timely filed and is evidence relevant to the present invention as indicia of unobviousness. As such, the Appellant notes that the Examiner does not appear to have considered the Declaration.", the examiner respectfully disagrees. The examiner fully considered the Declaration but found the evidence not persuasive. In a multi-billion dollar industry characterized by many players, a company with contract with one shipper and having annual revenues of about \$ 800,000 can hardly be construed as evidence of commercial success.

In response to Appellant's assertion "The pending claims are patently distinguishable over Williams in view of Le because both Williams and Le fail to disclose all of the features of the pending claims. For example, independent claim 1, as amended (emphasis added), recites:

A computer-implemented method for processing shipment and return of a package containing items from a Sender to a Recipient, the method comprising the steps of:

electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs;

electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender, from a shipping mechanism;

electronically adding the shipment tracking data to the database;

electronically correlating the package data in the database with the shipment tracking data;

electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker;

permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package; and

rendering data for display to an authorized user, based on a query of the database for shipping parameters of the package from the Sender to the Recipient and return from the Recipient to the Sender of the one more items of the items of the package.

Thus, the pending independent claims 1 and 33 are directed to a novel method and system for processing shipment and return of a package to destinations worldwide. (See Specification ¶ 29). Advantageously, the claimed invention supports international shipping and tracking of packages and pack, ago contents. (See Specification P 17 and 19).”, the examiner respectfully disagrees. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to Appellant's assertion “Williams appears to disclose a return tracking system where item data is stored upon the return of the item by the Recipient. Advantageously, the Appellant's invention is distinct from Williams because individual items within a package are tracked before being shipped by the Sender. (See Specification ¶ 17).”, the examiner respectfully disagrees. First of all there is nothing in paragraph 17 of the Applicant's specification to suggest that individual items within a package are tracked before being shipped by the Sender. Secondly, Williams discloses a computer-implemented method for processing shipment and return of a package containing items from a Sender to a Recipient (See the disclosure of Williams including the portions cited in the rejections). The limitations “sender” and “recipients” are given the broadest possible interpretation to include the “person who sends” and “the person who receives” regardless of whether the item is being shipped for the first time or is being returned. Williams in combination with Le discloses all the limitations of the claimed invention.

In response to Appellant's assertion "Le does not disclose a system where individual items within a package are tracked before being shipped by the Sender. Additionally, Le does not provide for return information for each item in a package, as is claimed", the examiner would like to point out that Le is not relied upon to teach these limitations. As discussed in the rejection above, the Williams reference is relied upon to teach these limitations.

The Appellant's other arguments with respect to pending claims have been considered but are not persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



Dr. Narayanswamy Subramanian
Primary Examiner,
Art Unit 3691
December 17, 2007

Conferees:

Alexander Kalinowski 
SPE, Art Unit 3691



Vincent Millin
Appeals Conference Specialist
Tech Center 3600